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PATENT
Customer No. 22,852
Attorney Docket No. 04853.0111-00000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
Nobuhiko NOMURA et al.) Group Art Unit: 1642
)
Application No.: 10/765,048) Examiner: Brandon J. FETTEROLF
)
Filed: January 28, 2004)
)
For: APOPTOSIS INDUCER AND) Confirmation No.: 9606
METHOD OF SCREENING FOR A)
SUBSTANCE INHIBITING)
ACYLATED HOMOSERINE)
LACTONE)

MAIL STOP AMENDMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE

Applicants now respond to the Office Action mailed October 16, 2006. The Examiner required restriction to one of the following groups of claims under 35 U.S.C. § 121:

Group I: claims 1-4, allegedly specifically drawn to a method of inhibiting AKT, classified in class 514, subclass 175;

Group II: claims 4-5*, allegedly specifically drawn to a method of screening for a substance inhibiting acylated homoserine lactone, classified in class 514, subclass 4;

Group III: claims 6-7 and 9-10, allegedly specifically drawn to an acylated homoserine lactone inhibitor, classified in class 530, subclass 317; and

* Applicants respectfully note the inclusion of claim 4 in both Groups I and II but believe that the Examiner had intended claim 4 to be part of Group II based on the dependency of claim 5 to claim 4. If this is incorrect, Applicants respectfully request clarification and correction as a further opportunity to respond.

Group IV: claims 8 and 11, allegedly specifically drawn to a kit for screening a substance which inhibits acylated homoserine lactone, classified in class 435, subclass 810.

Applicants provisionally elect Group II, claims 4-5, with traverse for at least the following reasons. Applicants believe that the different groups would not require separate and distinct searches, nor that it would be burdensome to search the inventions of all of the groups in light of the filing of only 11 claims and the existence of two groups (II and IV) with only 2 claims. In addition, Applicants respectfully request combining Group II with Group III, since all of the claims of Group III (6-7 and 9-10) depend from claims 4-5 of Group II.

The Office has stated that Groups III and II are related as product and process of use, and noted that where Applicants elect claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined according to the provisions of M.P.E.P. § 821.04. Office Action at 2-3.

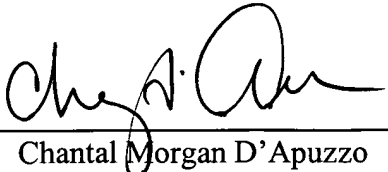
Here, Applicants respectfully request rejoinder of the nonelected product claims of Group III if a process claim of Group II is found to be allowable. As noted above, the claims of Group III each depend from a claim of Group II, and therefore contain all of the limitations of at least one process claim of Group II. In addition, Applicants retain the right to file one or more divisional and continuation applications directed to the non-elected subject matter.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: November 16, 2006

By: 
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